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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09/890,323	12/10/2001	Douglas P. Cerretti	2517-USA	9524

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EXAMINER
MOORE, WILLIAM W

ART UNIT	PAPER NUMBER
1652	7

DATE MAILED: 03/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.	Applicant(s)
09/890 323	CERRETTI, DOUGLAS P
Examiner	**Art Unit**
William W Moore	1652

Office Action Summary

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-44* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. §§121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

A. Nucleic acid compositions and related compositions and methods.

I. Claims 1-3 and 9-12, drawn, in clauses (a), (b) and (e) of claim 1, to a polynucleotide product of SEQ ID NO:7, or an isocoding polynucleotide, that encodes a SVPH-1a polypeptide, and to vectors and host cells comprising the polynucleotide, and to a first method of use of the polynucleotide in recombinant expression of the polypeptide in a host cell, classified under national practice in, *inter alia*, class 536, subclass 23.2.

II. Claims 1-3 and 9-12, alternately drawn, in clauses (a), (b) and (e) of claim 1, to a polynucleotide product of SEQ ID NO:8, or an isocoding polynucleotide, that encodes a SVPH-1b polypeptide, and to vectors and host cells comprising the polynucleotide, and to a first method of use of the polynucleotide in recombinant expression of the polypeptide in a host cell, classified under national practice in, *inter alia*, class 536, subclass 23.2.

III. Claims 1-3 and 9-12, alternately drawn, in clauses (a), (b) and (e) of claim 1, to a polynucleotide product of SEQ ID NO:9, or an isocoding polynucleotide, that encodes a SVPH-1c polypeptide, and to vectors and host cells comprising the polynucleotide, as well as to a first method of use of the polynucleotide in recombinant expression of the polypeptide in a host cell, classified under national practice in, *inter alia*, class 536, subclass 23.2.

IV. Claims 15-17 and 23-26, drawn, in clauses (a), (b) and (e) of claim 15, to a polynucleotide product of SEQ ID NO:3, or an isocoding polynucleotide, that encodes a SVPH-4 polypeptide, and to vectors and host cells comprising the polynucleotide, as well as to a first method of use of the polynucleotide in recombinant expression of the polypeptide in a host cell, classified under national practice in, *inter alia*, class 536, subclass 23.2.

V. Claims 15-17 and 23-26, alternately drawn, in clauses (a), (b) and (e) of claim 15, to a polynucleotide product of SEQ ID NO:10, or an isocoding polynucleotide, that encodes a SVPH-4a polypeptide, and to vectors and host cells comprising the polynucleotide, as well as to a first method of use of the polynucleotide in recombinant expression of the polypeptide in a host cell, classified under national practice in, *inter alia*, class 536, subclass 23.2.

VI. Claims 15-17 and 23-26, alternately drawn in clauses (a), (b) and (e) of

cells comprising the polynucleotide, as well as to a first method of use of the polynucleotide in recombinant expression of th e polypeptide in a host cell, classified under national practice in, *inter alia*, class 536, subclass 23.2.

VII. Claims 29-31 and 37-40, drawn, in clauses (a), (b) and (e) of claim 29, to a polynucleotide product of SEQ ID NO:2, or an isocoding polynucleotide, that encodes a SVPH-3 polypeptide, and to vectors and host cells comprising the polynucleotide, as well as to a first method of use of the polynucleotide in recombinant expression of the polypeptide in a host cell, classified under national practice in, *inter alia*, class 536, subclass 23.2.

VIII. Claims 1-3 and 9-12, drawn, in clauses (c) and (d) of claim 1, to a polynucleotide comprising a portion of SEQ ID NO:7, or to an oligonucleotide hybridizing therewith, and to vectors and host cells comprising the polynucleotide, classified under national practice in, *inter alia*, class 536, subclass 24.3.

IX. Claims 1-3 and 9-12, alternately drawn in clauses (c) and (d) of claim 1, to a polynucleotide comprising a portion of SEQ ID NO:8, or to an oligonucleotide hybridizing therewith, and to vectors and host cells comprising the polynucleotide, classified under national practice in, *inter alia*, class 536, subclass 24.3.

X. Claims 1-3 and 9-12, alternately drawn, in clauses (c) and (d) of claim 1, to a polynucleotide comprising a portion of SEQ ID NO:9, or to an oligonucleotide hybridizing therewith, and to vectors and host cells comprising the polynucleotide, classified under national practice in, *inter alia*, class 536, subclass 23.2.

XI. Claims 15-17 and 23-26, drawn, in clauses (c) and (d) of claim 15, to a polynucleotide comprising a portion of SEQ ID NO:3, or to an oligonucleotide hybridizing therewith, and to vectors and host cells comprising the polynucleotide, classified under national practice in, *inter alia*, class 536, subclass 24.3.

XII. Claims 15-17 and 23-26, alternately drawn in clauses (c) and (d) of claim 15, to a polynucleotide comprising a portion of SEQ ID NO:10, or to an oligonucleotide hybridizing therewith, and to vectors and host cells comprising the polynucleotide, classified under national practice in, *inter alia*, class 536, subclass 24.3.

XIII. Claims 15-17 and 23-26, alternately drawn, in clauses (c) and (d) of claim 15, to a polynucleotide comprising a portion of SEQ ID NO:11, or to an oligonucleotide hybridizing therewith, and to vectors and host cells comprising the polynucleotide, classified under national practice in, *inter alia*, class 536, subclass 23.2.

XIV. Claims 29-31 and 37-40, drawn, in clause (c) of claim 29, to a polynucleotide comprising a portion of SEQ ID NO:2, or to an oligonucleotide hybridizing therewith, and to vectors and host cells comprising the polynucleotide, classified under national practice in, *inter alia*, class 536, subclass 24.3.

XV. Claim 43, drawn to a polynucleotide product which is a naturally-occurring or man-made variegation of SEQ ID NO:7 that does not encode an SVPH-1a polypeptide of SEQ ID NO: 12, classified under national practice in class 536, subclass 23.1.

XVI. Claim 43, alternately drawn to a polynucleotide product which is a naturally-occurring or man made variegation of SEQ ID NO:8 that does not

encode an SVPH-1b polypeptide of SEQ ID NO:13, classified under national practice in class 536, subclass 23.1.

XVII. Claim 43, alternately drawn to a polynucleotide product which is a naturally-occurring or man-made variegation of SEQ ID NO:9, that does not encode an SVPH-1c polypeptide of SEQ ID NO:14, classified under national practice in class 536, subclass 23.2.

XVIII. Claim 44, drawn to a polynucleotide product which is a naturally-occurring or man-made variegation of SEQ ID NO:3 that does not encode an SVPH-4 polypeptide of SEQ ID NO:6, classified under national practice in class 536, subclass 23.1.

XIX. Claim 44, alternately drawn to a polynucleotide product which is a naturally-occurring or man-made variegation of SEQ ID NO:10 that does not encode an SVPH-4a polypeptide of SEQ ID NO:15, classified under national practice in class 536, subclass 23.1.

XX. Claim 44, alternately drawn to a polynucleotide product which is a naturally-occurring or man-made variegation of SEQ ID NO:11 that does not encode an SVPH-4c polypeptide of SEQ ID NO:16, classified under national practice in class 536, subclass 23.1.

XXI. Claims 29-31 and 37-40, alternately drawn, in clauses (d) and (f) of claim 29, to a polynucleotide product which is a naturally-occurring or man-made variegation of SEQ ID NO:2 that does not encode an SVPH -3 polypeptide of SEQ ID NO:5, to vectors and host cells comprising the polynucleotide, classified under national practice in class 536, subclass 23.1.

B. Disintegrin polypeptide and peptide compositions.

XXII. Claims 4-6 and 13, drawn to a SVPH-1a polypeptide of SEQ ID NO:12 or a polypeptide which comprises SEQ ID NO:12, classified under national practice in class 435, subclass 226.

XXIII. Claims 4-6 and 13, drawn to a SVPH-1b polypeptide of SEQ ID NO:13 or a polypeptide which comprises SEQ ID NO:13, classified under national practice in class 435, subclass 226.

XXIV. Claims 4-6 and 13, drawn to a SVPH- 1c polypeptide of SEQ ID NO:14 or a polypeptide which comprises SEQ ID NO:14, classified under national practice in class 435, subclass 226.

XXV. Claims 18-20 and 27, drawn to a SVPH-4a polypeptide of SEQ ID NO:3 or a polypeptide which comprises SEQ ID NO:3, classified under national practice in class 435, subclass 226.

XXVI. Claims 18-20 and 27, drawn to a SVPH-4a polypeptide of SEQ ID NO:10 or a polypeptide which comprises SEQ ID NO:10, classified under national practice in class 435, subclass 226.

XXVII. Claims 18-20 and 27, drawn to a SVPH-4b polypeptide of SEQ ID NO:11 or a polypeptide which comprises SEQ ID NO:11, classified under national practice in class 435, subclass 226.

XXVIII. Claims 32-34 and 41-43, drawn to a SVPH-3 polypeptide of SEQ ID

XXIX. Claims 13 and 14, drawn to a heterochimeric or an oligomeric polypeptide comprising a portion of SEQ ID NO:12, classified under national practice in class 530, subclass 350.

XXX. Claims 13 and 14, drawn to a heterochimeric or an oligomeric polypeptide comprising a portion of SEQ ID NO:13, classified under national practice in class 530, subclass 350.

XXXI. Claims 13 and 14, drawn to a heterochimeric or an oligomeric polypeptide comprising a portion of SEQ ID NO:14, classified under national practice in class 530, subclass 350.

XXXII. Claims 27 and 28, drawn to a heterochimeric or an oligomeric polypeptide comprising a portion of SEQ ID NO:6, classified under national practice in class 530, subclass 350.

XXXIII. Claims 27 and 28, drawn to a heterochimeric or an oligomeric polypeptide comprising a portion of SEQ ID NO:15, classified under national practice in class 530, subclass 350.

XXXIV. Claims 27 and 28, drawn to a heterochimeric or an oligomeric polypeptide comprising a portion of SEQ ID NO:16, classified under national practice in class 530, subclass 350.

C. Antibodies.

XXXV. Claims 7 and 8, drawn to an antibody product specific for the amino acid sequence of SEQ ID NO:12, classified under national practice in class 530, subclass 387.1.

XXXVI. Claims 7 and 8, alternately drawn to second antibody product specific for the amino acid sequence of SEQ ID NO:13, classified under national practice in class 530, subclass 387.1.

XXXVII. Claims 7 and 8, alternately drawn to third antibody product specific for the amino acid sequence of SEQ ID NO:14, classified under national practice in class 530, subclass 387.1.

XXXVIII. Claims 21 and 22, drawn to an antibody product specific for the amino acid sequence of SEQ ID NO:6, classified under national practice in class 530, subclass 387.1.

XXXIX. Claims 21 and 22, alternately drawn to an antibody product specific for the amino acid sequence of SEQ ID NO:15, classified under national practice in class 530, subclass 387.1.

XXXX. Claims 21 and 22, alternately drawn to an antibody product specific for the amino acid sequence of SEQ ID NO:16, classified under national practice in class 530, subclass 387.1.

XXXXI. Claims 36 and 37, drawn to an antibody product specific for the amino acid sequence of SEQ ID NO:5, classified under national practice in class 530, subclass 387.1.

Inventions of Groups I-XXI lack unity of invention, each with the other, because claims 1, 15, 29, 43 and 44 describe [illegible]

is disclosed to have a special technical feature defined by its coding capacity for a native protease having the various amino acid sequences of SEQ IDs NOs: 5, 6 and 12-16 or the amino acid sequences of chimeric polypeptides which need not comprise either the protease or the integrin domains of SEQ IDs NOs: 5, 6 and 12-16, whereby the coding capacity is not disclosed to share any further special technical feature common to any of the native proteases or chimeric polypeptides.

Inventions of Groups XXII-XXXIV lack unity of invention each with the other, because the claims describe as many as twenty-one separate and distinct polypeptide products where each is disclosed to have a special technical feature defined by the amino acid sequences of SEQ IDs NOs: 5, 6 and 12-16 or the amino acid sequences of chimeric polypeptides which need not comprise either the protease or the integrin domains of SEQ IDs NOs: 5, 6 and 12-16, where there is no disclosure that the native polypeptides or the chimeric polypeptides share any further special technical feature.

Inventions of Groups XXXV-XXXXI lack unity of invention each with the other, because the claims describe at least seven separate and distinct antibody products where each is required to be able to differentially identify one of the various polypeptides having a special technical feature defined by the amino acid sequences of SEQ IDs NOs: 5, 6 and 12-16, and may be required to identify an amino acid sequence of a chimeric polypeptide which need not comprise either the protease or the integrin domains of SEQ IDs NOs: 5, 6 and 12-16, where there is no disclosure that the native polypeptides or the chimeric polypeptides share any further special technical feature, thus the identifying antibodies cannot be considered to share any further special technical feature.

Inventions of Groups I-XXI lack unity of invention with inventions of Groups XXII - XXXIV and XXXV-XXXXI because polynucleotide products of Groups I -XXI are not constrained by claims 1, 15, 29, 43 and 44 to encode a single, corresponding, polypeptide of Groups XXII-XXXIV and cannot encode an antibody of claims of Groups XXXV-XXXXI.

Inventions of Groups XXII-XXXIV lack unity of invention with inventions of Groups XXXV-XXXXI because the polypeptides of Groups XXII -XXXIV cannot share any common structural features with the antibodies of Groups XXII-XXXIV.

Because these inventions lack unity and are distinct for the reasons given above, and have acquired a separate status in the art as shown by their different classification s, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR §1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR §1.48(b) and by the fee required under 37 CFR §1.17(h).

A telephone call was made to Mr. Joseph R. Baker on March 12, 2002, to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William W. Moore whose telephone number is 703.308.0583. The examiner can normally be reached between 7:00AM-5:30PM EST on Mondays and Wednesdays, between 7:00AM-1:30PM EST on Tuesdays and Thursdays, and between 8:30AM and 5:00PM EST on Fridays. The examiner's direct FAX telephone number is 703.746.3169. if attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached at 703.308.3804. Further fax phone numbers for the organization where this application or proceeding is assigned are 703.308.4242 for regular communications and 703.308.0294 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed t o the receptionist whose telephone number is 703.308.0196.

William W. Moore
March 13, 2002